

**This Opinion is Not a
Precedent of the TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re 1-800-FLOWERS.COM, Inc.
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Serial No. 88690528
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Carolyn A. Galgano and Thomas M. Galgano of Galgano IP Law PLLC,
for 1-800-FLOWERS.COM, Inc.

Curtis W. French, Trademark Examining Attorney, Law Office 130,
John Lincoski, Managing Attorney.

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Before Shaw, Greenbaum and Goodman,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

1-800-FLOWERS.COM, Inc. (“Applicant”) seeks registration on the Principal Register of the mark EVERLASTING ROSE (in standard characters, ROSE disclaimed) for

Ornaments of glass; Ornaments of glass, namely, glass
roses, in International Class 21.¹

¹ Application Serial No. 88690528 was filed on November 13, 2019, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used with the identified goods, so resembles the registered mark EVERLASTING ROSE (in standard characters, ROSE disclaimed) for "Dried flower arrangements; Dried flowers; Flowers, dried, for decoration," in International Class 31 as to be likely to cause confusion, mistake or deception.²

After the Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

² Registration No. 5906147 issued on November 12, 2019.

A. Similarity or Dissimilarity of the Marks

Applicant's mark is identical to the mark in the cited registration in "appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). This *DuPont* factor thus weighs strongly in favor of a finding that confusion is likely.

B. Strength of the Mark in the Cited Registration

Despite the identity in the marks, Applicant argues that the term "Everlasting" and variations thereof commonly are used for flowers, flower holders, and related goods, and thus the mark in the cited registration, EVERLASTING ROSE, is entitled to a narrow scope of protection or exclusivity of use. App. Br., 4 TTABVue 4.

"A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace [or commercial] strength (secondary meaning)." *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). For likelihood of confusion purposes, "the strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak." *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003).

Evidence of third-party use and registration of a term in the relevant industry is considered in the likelihood of confusion analysis. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015). *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797

F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016) (citing *Juice Generation*, 115 USPQ2d at 1674).

Here, Applicant submitted no evidence of actual third-party uses, and instead relies on a dictionary definition of “everlasting” from Wiktionary, which defines “everlasting” as “lasting or enduring forever” and as synonymous with “eternal” (August 23, 2020 Response to Office Action, TSDR 103), and three third-party registered marks that include the term EVERLASTING or variations thereof.³ *Id.*, TSDR 37, 39 and 40. The record thus does not demonstrate commercial weakness from third-party use, and fails to show that consumers actually are conditioned to distinguish among marks that include EVERLASTING (or variations thereof). *See In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (“Applicant’s citation of third-party registrations as evidence of market weakness is unavailing because third-party registrations standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences.”); *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013) (“[T]he mere existence of third-party

³ Applicant included the cited registered mark (Reg. No. 5906147) and an unregistered mark (Serial No. 87015020 for EVERLAST E with design, for flower pots) in its list of third-party registrations. August 23, 2020 Response to Office Action, TSDR 38 and 41-46. As neither is a third-party registration, we do not include them in our tally. In addition, the pending application is not evidence of use; it is evidence only that the application was filed on a certain date. *In re Embiid*, 2021 USPQ2d 577, at*36 (TTAB 2021); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016).

registrations is not evidence that the registered marks are actually in use or that the public is familiar with them.”).

We now turn to the three third-party registrations of record: EVERLASTIN’ (Reg. No. 1806156) for “holders for flowers, namely, baskets for flower arrangements”; EVERLASTING (Reg. No. 4403063) for “live plants, namely, hydrangeas”; and EVERLASTING FLOWERS and Design (Reg. No. 5931285) for “jewelry.” August 23, 2020 Response to Office Action, TSDR 37, 39 and 40. We also consider the dictionary definition of “everlasting.” *Id.*, TSDR 103.

The probative value of the third-party registrations alone is in showing the sense in which the term EVERLASTING is used and understood. *Juice Generation*, 115 USPQ2d at 1675; *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976) (third-party registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”); *Institut Nat’l Des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (“Third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.”). As the Board explained in *Morinaga*, third-party registrations can be used in the manner of a dictionary as “evidence that a term is suggestive or descriptive of the relevant goods or services. Such terms may be conceptually weak because the more descriptive a term is, the less likely prospective purchasers are to attach source-identifying significance to it.” *Morinaga*, 120 USPQ2d 1738, 1745-46 (TTAB 2016).

But even if the term “everlasting” has a recognized meaning, i.e., lasting forever, as per the Wiktionary definition, Applicant’s third-party registration evidence does not support a finding that the meaning is descriptive of dried flowers. Rather, we find the term “everlasting” to be suggestive of the dried flowers identified in the cited registration, as consumers would expect the dried flowers to last longer than live flowers, but they would not expect them to last literally forever.

Moreover, none of the three third-party registrations includes both EVERLASTING and ROSE. Indeed, none of them includes the term ROSE. Thus, none of them is as close to the cited registered mark as is Applicant’s identical mark EVERLASTING ROSE. The probative value of these third-party registrations is therefore minimal, at best.

Applicant also points to arguments Registrant made during prosecution of its application, when Registrant faced a Section 2(d) refusal to register based on a likelihood of confusion with Reg. No. 4403063 for EVERLASTING, for “live plants, namely, hydrangeas” (one of the three third-party registrations discussed in the preceding paragraph), as an admission by Registrant that EVERLASTING is a weak mark. 4 TTABVUE 9. However, Applicant overstates the effect of such arguments. Applicant essentially is asserting that Registrant’s statements in its application for registration are file wrapper estoppel. File wrapper estoppel is not applicable in trademark cases, nor is it an admission against interest. *See Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153-54 (CCPA 1978) (finding that a likelihood of confusion argument made in support of an application for

registration is a legal conclusion, and therefore, cannot constitute an admission because only facts may be admitted); *Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 USPQ2d 1213, 1233 (TTAB 2011) (recognizing that a party's position in a prior proceeding "is not an admission, but may be considered only as illuminative of shade and tone in the total picture"); *Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ 1271, 1281 (TTAB 2009), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010) ("The doctrine of 'file wrapper estoppel' does not apply in trademark cases" nor does a party's position in a prior proceeding "rise to the level of an admission against interest."); *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156 (TTAB 1975) (fact that petitioner argued before examining attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation).

In any event, Registrant's asserted position in prosecuting the underlying application for the cited registration has limited probative value. *See Specialty Brands, Inc. v. Coffee Bean Distrib., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (TTAB 1984) ("[W]e place only limited weight on these statements in the application file.").

[T]hat a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. To that limited extent, a party's earlier contrary opinion may be considered relevant and competent.

Specialty Brands, 223 USPQ at 1283 (quoting *Interstate Brands*, 198 USPQ at 154).

In sum, while use of a term by third parties in connection with the same or similar goods may serve to diminish the scope of protection to be extended the cited registered

mark, this record, with at best, three examples, is not sufficient to support such a finding. *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017). Registrant's arguments in its application for registration do not compel a different result. Accordingly, we do not find the cited registered mark is weak, and we accord it the normal scope of protection afforded to inherently distinctive marks.

In making this finding, we have kept in mind that the term EVERLASTING, when used in connection with dried flowers, such as those identified in the cited registration, has a positive connotation of durability, and thus it is not entirely arbitrary for those goods. On this record, however, that EVERLASTING is not entirely arbitrary does not affect our conclusion as to the scope of protection to which the registered mark. EVERLASTING ROSE, is due.

C. Similarity or Dissimilarity of the Goods and Channels of Trade

We turn next to the *DuPont* factors involving the similarity of the goods, and the similarity of established, likely to continue channels of trade. We base our evaluation on the goods as they are identified in the application and cited registration. *See In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The second *DuPont* factor “considers whether ‘the consuming public may perceive [the respective goods] as related enough to cause confusion about the source or origin

of the goods....” *St. Helena Hosp.*, 113 USPQ2d at 1086 (quoting *Hewlett-Packard*, 62 USPQ2d at 1004). The goods identified in the application comprise “ornaments of glass” and “ornaments of glass, namely, glass roses,” and the goods identified in the registration are “dried flower arrangements,” “dried flowers,” and “flowers, dried, for decoration.”

Although the goods identified in the application and cited registration are not identical, identity is not required to support a finding of likelihood of confusion. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (“[I]t is not necessary that the products of the parties be similar or even competitive to support a finding of likelihood of confusion.”). *See also On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000) (The goods need not be identical or even competitive to find a likelihood of confusion). Rather “likelihood of confusion can be found ‘if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). The issue is whether there is a likelihood of confusion as to the source of the goods, not whether purchasers would confuse the goods. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). Also, where, as here, the involved marks are identical, the degree of similarity between the goods required for confusion to be likely declines. *See, e.g., In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993) (“[E]ven

when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source.”). It is only necessary that there be a viable relationship between the goods to support a finding of likelihood of confusion. *In re Concordia Int’l Forwarding Corp.*, 225 USPQ 355, 356 (TTAB 1983).

Here, the goods identified in the application and cited registration are related on their face in that both cover goods of a type that may be used (separately or together) as decorative home décor enhancements for rooms and as centerpieces for tables or mantles. Indeed, in arguing that the goods are different, Applicant states that its goods “are decorative in nature and are intended to be used as an attractive embellishment for a room or a centerpiece.” August 23, 2020 Response to Office Action, TSDR 3. However, the record demonstrates that the same may be said for “dried flowers,” such as those identified in the cited registration. For example, an online search of the etsy.com website returned nearly 4000 results of dried flowers used as centerpieces. September 4, 2020 Final Office Action, TSDR 7-12.

Further, the broadly worded “ornaments of glass” identified in the application include glass ornaments that may be sold filled with “dried flowers” such as those identified in the cited registration for use as a decoration or as a keepsake.⁴ *See in re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s

⁴ Reg. No. 4798142 for MEMORY BULBS, for “Ornaments of glass filled with customer’s special occasion dried flowers and customized with a charm and ribbon, sold as a keepsake,” listed below, is an example of this type of combination. February 24, 2020 Office Action, TSDR 26-27.

broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

The evidentiary record, which consists of Internet and third-party registration evidence, also supports a finding that the goods are related. We turn first to the Internet evidence. The Examining Attorney made of record screenshots from the third-party commercial websites of Afloral, which sells dried and preserved flowers and Christmas ornaments, and Kremp Florist, which sells dried flower wreaths and assorted glass flowers, under their eponymous marks. September 4, 2020 Final Office Action, TSDR 37-47 and 111-14. He also made of record a three-page screenshot of Applicant’s own 1800flowers.com website, which includes a landing page for “Preserved & Artificial Flowers and Plants” featuring a “Waterford Crystal Rose” and preserved flower wreaths. February 24, 2020 Office Action, TSDR 2-4.

Applicant attempts to diminish the probative value of the three-page screenshot from its own website by arguing that it is a “large flower and gift retailer that sells a wide variety of goods in addition to flowers, such as food items, clothing, jewelry, stuffed animals, candles, snow globes, keepsakes, etc.[.]” and that it is similar to large retailers such as Target, Walmart and Amazon in that “customers can buy a variety of products at Applicant’s online store.”⁵ App. Brief, 4 TTABVUE 11. Consequently, argues Applicant, “just because Applicant offers both types of products does not mean

⁵ As support, Applicant points to the “Keepsake Gifts” pages from its website showing various goods such as flowers, teddy bears, balloons and candies. August 23, 2020 Response to Office Action, TSDR 10-35.

that the goods are related despite being sold ‘under the same roof.’ In fact, there is no such thing as an ‘under the same roof’ rule.” *Id.*, 4 TTABVUE 11-12.

We agree that there is no “under the same roof” rule, and the Examining Attorney did not so argue. *See Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (“The law is that products should not be deemed related simply because they are sold in the same kind of establishments.”). However, the evidence does not support Applicant’s attempt to liken itself to a “big box” store, where a purchaser would expect to encounter a wide variety of goods such as power tools, exercise equipment, office supplies, electronics and bath and beauty products. Rather, the record, which includes printouts from Applicant’s website (August 23, 2020 Response to Office Action, TSDR 10-35) and articles about the range of goods offered by florists (September 4, 2020 Final Office Action, TSDR 48-60), supports a finding that Applicant is an online florist and gift retailer who provides a limited range of goods commonly offered by other flower and gift retailers, such as jewelry, candles, collectibles, and seasonal gift items.

Nor does the Examining Attorney argue that the goods identified in the application and registration are related “just because” they appear on Applicant’s website. As additional evidence that the goods identified in the application and registration are related, the Examining Attorney made of record several use-based, third-party registrations of marks identifying dried flowers and glass ornaments or figurines:

- Reg. No. 1771023 for GUMP’S (crystal figurines and dried flowers);

- Reg. No. 3971157 for STYLEHAPPY (decorative glass figurines and dried flowers);
- Reg. No. 3438019 for HARVEST MOON (glass ornaments, and artificial and dried flowers);
- Reg. No. 3438020 for WITCH CRAFTERS (glass ornaments, and artificial and dried flowers); and
- Reg. No. 1785586 for GARCIA GROUP (ornaments for Christmas trees, and artificial and dried flowers); as well as
- Reg. No. 4798142 for MEMORY BULBS (glass ornaments filled with dried flowers for use as a keepsake).⁶

The Examining Attorney also submitted approximately ten other use-based, third party registrations of marks identifying retail florists or retail/wholesale stores featuring artificial or dried flowers as well as ornaments, figurines, collectibles and other gifts and home décor items. Some of the registrations also identify dried flowers. The following registrations are illustrative:

- Reg. No. 2521630 for TRIAS (dried flowers, and retail florist shops and on-line retail store services featuring dried flowers and decorative figurines);

⁶ The registrations for GUMP'S, STYLEHAPPY, HARVEST MOON, WITCH CRAFTERS and MEMORY BULBS are attached to the February 24, 2020 Office Action, TSDR 8-21, and 26-27. The registration for GARCIA GROUP is attached to the September 4, 2020 Final Office Action, TSDR 61-65.

- Reg. No. 3515782 for GRASMERE (retail shops and on-line retail store services featuring dried flowers and “home décor, namely, Christmas tree ornaments”);
- Reg. No. 3559328 for CALYX FLOWERS (dried flowers, and wholesale, retail catalog and mail order services featuring flowers and gifts);
- Reg. No. 2869179 for BENEVA FLOWERS (retail store services featuring artificial and dried flowers, gifts, and “home decorating items and accessories”); and
- Reg. No. 4985068 for BE THE REASON THEY SMILE (retail store services featuring artificial and dried flowers, gifts, “home decorating items and accessories,” and collectibles).⁷

While third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, such registrations that individually cover a number of different items and are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods are of a type which may emanate from a single source. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); *see also In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

⁷ The registrations for TRIAS, GRASMERE, CALYX FLOWERS are attached to the September 4, 2020 Final Office Action, TSDR 64-72. The registrations for BENEVA and BE THE REASON THEY SMILE are attached to the September 4, 2020 Final Office Action, TSDR 75-77 and 90-92.

The facial relationship between the identified goods, the evidence from Applicant's and third-party websites and articles, and the third-party registration evidence collectively support a finding that the goods identified in the application and cited registration are related for purposes of our likelihood of confusion analysis.

Turning to the channels of trade and classes of purchasers, we initially note that neither identification of goods in the application or cited registration includes any restriction regarding channels of trade, consumer or price; we must therefore presume that the recited goods are sold in the ordinary or normal trade channels for such goods, to all consumers for such goods and without any limitation to price. *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000) ("When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade."); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). The Internet evidence demonstrating that the goods identified in the application and cited registration are related also supports a finding that such goods move in the same channels of trade, namely, florist shops, and they are sold to the same classes of consumers, namely, members of the general public. Thus, the channels of trade and classes of purchasers for the goods overlap.

We find that the second and third *DuPont* factors weigh in favor of finding likelihood of confusion.

II. Conclusion

Having considered all evidence and arguments bearing on the relevant *DuPont* factors, we conclude that Applicant's mark EVERLASTING ROSE for "Ornaments of glass; Ornaments of glass, namely, glass roses" is likely to cause confusion with Registrant's identical mark EVERLASTING ROSE for "Dried flower arrangements; Dried flowers; Flowers, dried, for decoration."

Decision: The refusal to register Applicant's mark EVERLASTING ROSE is affirmed.